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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,386	11/05/2003	Makoto Suzuki	Q78247	6365
23373	7590	12/13/2004		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER SCHILLING, RICHARD L	
			ART UNIT 1752	PAPER NUMBER

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/701,386	Applicant(s) SUZUKI ET AL.	
	Examiner Richard L Schilling	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2-26-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

Art Unit 1752

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the

invention was made.

Claims 1, 2, 5 and 8 are rejected under 35 U.S.C. § 102(e) as being fully met by Nakai et al. Nakai et al. (see particularly column 2, lines 9-67) disclose processing solutions comprising residual color reducing compounds to remove residual sensitizing dye wherein the compounds comprise aromatic rings and aromatic heterocyclic rings and are within the scope of Formula I of instant claim 2. The photographic materials of Nakai et al. contain the residual sensitizing dye reducing compounds after being treated with the processing solution and are still photosensitive prior to fixing.

2. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goswami et al. Goswami et al. (see particularly column 2, line 6 - column 3, line 21) discloses treating solutions with residual sensitizing dye reducing compounds within the scope of Formula I of instant claim 2. Naphthyl groups are preferred for  $A_r$  in Goswami et al. and sulfo and carboxy groups are preferred as substituents for the  $A_r$  groups. In regard to instant claims 4, 7 and 10, it would at least be obvious to one skilled in the art to use the preferred naphthyl groups for  $A_r$  along with preferred carboxy substituents in the residual dye reducing compounds of Goswami et al. The photographic materials

of Goswami et al. would contain the residual dye reducing compounds after treatment with the treating solutions and still have light sensitivity prior to fixing.

3. Claims 1-10 are rejected under 35 U.S.C. § 102(e) as being fully met by Suzuki et al. '134. Suzuki et al. (see particularly column 2, lines 13-45; compound 2) discloses processing solutions with residual sensitizing dye reducing aromatic compounds including compounds with carboxy substituted naphthyl rings within the scope of Formula I of instant claim 2.

The photographic materials of Suzuki et al. would contain the residual sensitizing dye reducing compounds after being treated with the processing solution.

4. Claims 11-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakai et al., Goswami et al. or Suzuki et al. '134 all further in view of Parton et al. and Yamashita et al. Yamashita et al. (see particularly column 1, line 58 - column 2, line 20; column 3, lines 36-53) and Parton et al. (see particularly column 2, line 55 - column 3, line 36; column 31, lines 49-60) disclose that it is known in the art to improve light absorption and spectral sensitivity of silver halide grains by using multiple layers of sensitizing dyes. As explained in paragraphs 1-3 above, Suzuki et al., Goswami et al. and Nakai et al. disclose color photographic elements containing dye

sensitized silver halide grains wherein the elements are processed with solutions containing residual sensitizing dye reducing compounds with aromatic groups. It would be obvious to one skilled in the art to use silver halide grains sensitized with multiple layers of sensitizing dyes as disclosed in Yamashita et al. and Parton et al. in order to provide elements with increased light absorption and spectral sensitivity in Nakai et al., Goswami et al. or Suzuki et al. Alternatively, it would be obvious to one skilled in the art to use the processing solutions with residual sensitizing dye removing agents as set forth in Suzuki et al., Nakai et al. or Goswami et al. as the processing solutions in Yamashita et al. or Parton et al. in order to reduce residual sensitizing dye stain in Parton et al. and Yamashita et al.

5. Claims 1, 2, 5, 8, 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yamashita et al. and European Patent Publication 277509. Yamashita et al. (see particularly column 1, line 35 - column 2, line 20; column 50, lines 52-67) disclose color photographic materials with sensitizing dyes forming multiple layers absorbed on silver halide grains. Yamashita et al. disclose incorporating compounds into their elements to reduce color stain due to the presence of residual color developing agent or other side

reactions after processing. The residual color stain reducing agents useful in Yamashita et al. are disclosed, by incorporation by reference, as being those of European Patent Publication 277,589. The European Patent Publication (see particularly page 4, lines 25-55; pages 8-31; compounds 16, 21, 23, 28, 51, 81-90) include aromatic compounds including compounds with two aromatic rings joined by linkages containing double bonds within the scope of Formula 1 of instant claim 2. Therefore, it would at least be obvious to one skilled in the art to use the aromatic ring containing residual color reducing agents of the European patent publication to reduce residual color stain in Yamashita et al.

6. Claims 1, 2, 5, 8, 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Parton et al. and Morigaki et al. Parton et al. (see particularly column 2, line 55 - column 3, line 26; column 31, lines 49-60) discloses photographic silver halide elements with multiple layered sensitizing dyes with silver halide grains which may contain the stain reducing agents of U.S. Patent 5,068,171 to Morigaki et al. incorporated by reference. The stain reducing agents of Morigaki et al. (see particularly column 3, line 4 - column 4, line 15; column 41, lines 38-50; compounds I-10, 18, 30-41, 51, 60-63; III-1, 30-34, 37-40, 58) include those with aromatic rings including two aromatic rings as in Formula 1 of

instant claim 2 which would at least be obvious to use in Parton to reduce stain.

7. Claims 1, 2, 5 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Vargas et al. Vargas et al. (see particularly column 3, lines 1-32; column 6, lines 38-49) disclose silver halide photographic materials with residual sensitizing dye reducing compounds within the scope of Formula I of instant claim 2 when R in Vargas is aromatic.

8. Claims 1, 2, 5 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Merkel et al. Merkel et al. (see particularly column 2, lines 2-53; compounds 8-10) disclose silver halide photographic materials containing compounds that reduce sensitizing dye stain or residual color within the scope of Formula I of instant claim 2 when R<sup>1</sup> and R<sup>2</sup> in Merkel are phenyl.

9. Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita et al. or Parton et al. both in view of Vargas et al. and Merkel et al. Parton et al. and Yamashita et al. disclose color photographic materials with silver halide sensitized with multiple layers of sensitizing dyes in order to increase light absorption and spectral sensitivity. Vargas et al. and Merkel et al. disclose dye sensitized silver halide color photographic elements containing compounds that



reduce residual sensitizing dye to prevent dye stain. The compounds in Vargas et al. and Merkel et al. are within the scope of Formula I of instant claim 2 as explained in paragraphs 7 and 8 above. It would be obvious to one skilled in the art to use multiple layers of sensitizing dyes as taught in Parton et al. and Yamashita et al. to sensitize the silver halide grains in Vargas et al. and Merkel et al. in order to increase light absorption and spectral sensitivity in the elements of Vargas et al. and Merkel et al. Alternatively, it would be obvious to one skilled in the art to use the residual sensitizing dye reducing compounds of Vargas et al. and Merkel et al. containing aromatic rings in the silver halide photographic elements of Parton et al. or Yamashita et al. in order to reduce residual sensitizing dye stain.

10. The prior art submitted by applicants has been considered. Ikegawa et al. and Singer et al. are cited of interest in the art as disclosing silver halide elements with aromatic residual sensitizing dye reducing compounds. Suzuki et al. '902 is cited of interest in the art as disclosing processing solutions with residual sensitizing dye reducing compounds containing two linked aromatic rings.

11. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

Serial No. 10/701,386

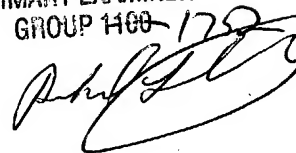
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RLSchilling:cdc

December 9, 2004

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1400-1752

A handwritten signature in black ink, appearing to read 'R. Schilling', is written over the printed name and title.